

DOCKET NO: 218360US0

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
HIROMI NAMBU, ET AL. : EXAMINER: FUBARA, BLESSING M.
SERIAL NO: 10/053,658 :
FILED: JANUARY 24, 2002 : GROUP ART UNIT: 1618
FOR: DEPILATORY COMPOSITION :

RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Responsive to the Notice of Non-Compliant Appeal Brief of September 24, 2008,
Appellants request review of the rejections in the above-identified application by the Board
of Patent Appeals and Interferences in view of the following Remarks.

REMARKS

In the Notice of Non-Compliant Appeal Brief of September 24, 2008, the Office asserts that the Appeal Brief filed on September 12, 2008 does not present an argument under a separate heading for each ground of rejection on appeal (see line no. 6 of the September 24, Notice). It appears that the Office further asserts that the arguments section does not match the grounds section insomuch as each ground of rejection does not correspond to heading within the argument section (see line no. 10 of the Notice).

Applicants submit that the Appeal Brief filed in the present application on September 12, 2008, does in fact present an argument under a separate heading for each ground of rejection. The September 12, 2008 Appeal Brief identified two grounds of rejection as ground “**I**” and “**II**”. Grounds **I** and **II** correspond with the rejections under 35 U.S.C. § 112 and 35 U.S.C. § 103, respectively, set forth in the June 13, 2008 Office Action.

Applicants further submit that the Appeal Brief provides an argument for each ground of rejection in a manner such that each argument corresponds with the section headings of the grounds of rejection. In fact, the argument section of the September 12, 2008 Appeal Brief includes an argument heading that corresponds with each of the Office rejections. Thus, the Argument section includes three reasons (i.e., “**(Ia)-(Ic)**”) why the rejection of the claims under 35 U.S.C. § 112 is incorrect as set forth as Ground “**I**”.

The Argument section of the September 12, 2008 Appeal Brief, also provided an argument why the rejection under 35 U.S.C. § 103 is not correct. This argument includes a heading identified as “**II**” which directly corresponds to the ground of rejection “**II**” set forth in the grounds of rejection section of the September 12, 2008 Appeal Brief. In addition, argument “**II**” includes five reasons why the rejection under 35 U.S.C. § 103 is not correct

(i.e., A-E). Each of A-E is presented as a subheading under the heading “II” which corresponds to the ground of rejection “II”.

Applicants thus submit that the Office’s basis for mailing the Notice of September 24, 2008 is not supportable. Applicants respectfully request the Appeal Brief be forwarded to the Board for decision.

For convenience, the Grounds of Rejection and Argument section of the September 12, 2008 Appeal Brief are reproduced below in a manner that is substantially identical to the form in which the Grounds of Rejection and Argument section were submitted in the September 12, 2008 Appeal Brief.

VI. GROUND OF REJECTION

I. Claims 1, 3-5, 7-8, 10-22, 30-36, and 41-42 are rejected under 35 U.S.C. § 112, second paragraph as indefinite. **I (a)** The Examiner asserts that terms “depilatory gel” and “keratin reducing compound” are not clear. **I (b)** The Examiner asserts that method Claims 20, 30, 35, and 36 “recite only the steps of doing something without telling what the method is.” **I (c)** The Examiner also asserts that Claim 1 is confusing in the last two lines of the claim.

II. Claims 1, 3-5, 7-8, 10-22, 30-36, and 41-42 are rejected as obvious under the meaning 35 U.S.C. § 103(a) over Guillaume (WO 98/44898) in combination with Combe (US 5,141,560). The Examiner provides its rationale for rejecting the claims as obvious in paragraph nos. 3 and 4 on pages 4 and 5 of the June 13, 2008 Office Action.

VII. ARGUMENT

Responsive to Appellants’ arguments set forth in the Appeal Brief submitted on February 4, 2008, the Office reopened prosecution in this case. The Examiner now rejects the claims in view of art already considered during prosecution (see the Examiner’s rejection of the claims over Guillaume set forth in the Office Action of July 28, 2003 and Appellants’ response of September 15, 2003).

I (a). The evidence of record shows that those of skill in the art understand the meaning of the contested terms.

The Examiner asserts that the terms “depilatory gel” and “keratin reducing compound” are indefinite and/or unclear. Appellants submit that the evidence of record shows that those of ordinary skill in the art readily recognize and understand the terms

asserted by the Examiner to be indefinite and/or unclear. For example, the art relied on by the Examiner to reject the claims as obvious (see further arguments below) describes depilatory compositions (see for example in the Abstract of Guillaume which refers to a “depilatory composition”). Further evidence showing that those of ordinary skill in the art would readily understand the meaning of the term “depilatory gel” is provided on pages 1-3 of the present specification where other depilatory compositions are described.

With regard to the word “gel”, Appellants draw the Board’s attention to the paragraph bridging pages 27 and 28 of the specification which explicitly recites viscosities which the gel composition may have. Moreover, independent Claim 1 recites a gel depilatory composition having a viscosity in the range of 500,000 mPa·s to 20,000,000 mPa·s.

Appellants thus submit that those of ordinary skill in the art would readily recognize the meaning of the terms “depilatory”, “gel” and “depilatory gel.” As they appear in the present claims.

With regard to the term “keratin reducing compound” Appellants draw the Board’s attention to pages 4-7 of the specification which describe the keratin reducing compound recited in present Claim 1. The specification discloses the properties of the keratin reducing compound recited in the claims and a group of chemical compounds which includes the keratin reducing compound. At least dependent Claim 10 recites a Markush group of chemical compounds for the keratin reducing compound recited in Claim 1.

Appellants submit that the evidence of record including the art cited by the Examiner (i.e., Guillaume) and the disclosure of the present specification make it clear that those of ordinary skill in the art would readily recognize and understand the terms “depilatory gel” and “keratin reducing compound” as they are recited in the present claims.

I (b). Claims 20, 30 and 30-35 recite the active steps of a process; there is no requirement under the U.S. Patent Laws that a process claim include a descriptive preamble

The Examiner asserts that method Claims 20, 30, and 35 “do not recite what the method is about or what method is that is being claimed. The claims recite only the steps of doing something without telling what the method is.”

Appellants submit that the rejection makes no sense on its face. Each of dependent Claims 20, 30, and 35-36 explicitly recite active steps including (i) applying the depilatory gel sheet of Claim 1 to a portion of a body requiring depilation and (ii) peeling off or removing the depilatory gel sheet from the body. Appellants submit that the Examiner’s basis for rejecting the claims as indefinite because the claims “recite only the steps of doing something” is not supportable.

I (c). The “crosslinked” term of Claim 1 refers to a structural property of the claimed invention, not a process, and is therefore not indefinite.

The Examiner further asserted that the last two lines of Claim 1 are confusing. It appears that the Examiner is of the opinion that the last two lines of Claim 1 refer to a process. Appellants submit that it is readily recognized that the last two lines of Claim 1 recite a structural feature of one of the components of the claimed depilatory gel sheet. The last two lines of Claim 1 recite a hydrophilic polymeric compound (i.e., identified as component (b) in Claim 1) that is crosslinked (e.g., chemically bonded) with an ionic-bonding crosslinking agent (i.e., identified as component (c) of Claim 1).

The last two lines of Claim 1 do not recite a process of making the polymeric composition but instead recite a structural feature describing the chemical bonding between the ionic-bonding crosslinking agent and the hydrophilic polymeric compound.

Appellants submit that the explanations provided above in response to paragraph nos. 4-6 of the June 13, 2008 Office Action show that the rejection of the claims under 35 U.S.C. § 112 is not supportable and should be withdrawn.

II. The Examiner failed to set forth a *prima facie* case of obviousness with respect to the pending claims.

A. The Guillaume and Combe publications are in non-analogous arts and thus their combination cannot set forth a *prima facie* case of obviousness.

Appellants draw the Board's attention to MPEP § 2141.01(a). This description of USPTO administrative guidelines makes it clear that in order for an Examiner to rely on a combination of references to support an obviousness rejection, the references must be analogous prior art. Appellants submit that Guillaume and Combe are in non-analogous arts and thus cannot properly be used as a basis that the claimed invention is obvious.

Combe describes compositions having substantially different properties and a contradictory functionality in comparison to the gel depilatory composition and depilatory gel sheet recited in the present claims. Appellants submit that it is readily recognized by those of skill in the art that a cement (e.g., the dental cement of Combe) is a material that sets (e.g., cures) to form a solid. In fact, Combe explicitly describes compositions which set to form a solid material (see the examples of Combe). Appellants submit that compositions which set to form solids are different in function and structure than the gel depilatory compositions of

Guillaume. Guillaume describes a depilatory composition that contains a composition that is in the form of a gel whereas Combe describes a dental cement that sets to form a solid.

The compositions of Guillaume and Combe have entirely different goals and are directed to solving different problems, thus those of skill in the art would not combine Combe with Guillaume in the manner asserted by the Examiner.

- B.** The art cited by the Examiner does not disclose or suggest a depilatory gel sheet that comprises a gel depilatory composition and a support.

Guillaume does not disclose or suggest a gel depilatory composition applied onto a support. In fact, Guillaume describes a composition which “may be sprayed onto the skin” (see page 2, line 14) and “may alternatively be applied by means of a roll-on device or in conventional shower gel packaging” (see the paragraph bridging pages 9 and 10 of Guillaume). Combe does not cure this deficiency of Guillaume.

Appellants submit that the rejection should be withdrawn at least for the reason that the cited art does not disclose or suggest all of the present claim limitations.

With respect to Claims 20-36, drawn to methods, Appellants point out that the methods of application disclosed in Guillaume, e.g., spray-on and roll-on, do not suggest the applying step recited in the method claims. The applying of the present claims includes contacting a depilatory gel sheet having a support with a portion of a body in need of depilation. Guillaume’s teaching of spray-on, roll-on or shower gel products does not suggest the applying of the present claims. Likewise, Combe describes applying a cementitious composition to teeth in the absence of any support. Thus, the method claims (i.e., Claims 20-36) are further patentable over the art of record.

- C. Guillaume disparages cross-linked polymers that are ionically cross-linked and thus teaches away from the presently claimed invention.

Guillaume discloses that the first component of the prior art depilatory composition is cross-linked in a manner that is contradictory to the presently claimed invention. For example (underlining added):

The cross-linked polymer of the first component is such that it swells at high pH (pH 10.5 to 13) and preferably has only carbon-carbon cross-linkages.

See the paragraph bridging pages 4 and 5 of Guillaume.

The only crosslinking disclosed for the first polymeric component of Guillaume is crosslinking that occurs by carbon-carbon bond linkages. In fact on page 8, the first component is described as one that is “cross-linked with dodecadiene”. Likewise, the examples of Guillaume disclose the polymers that are cross-linked with dodecadiene. Appellants submit that dodecadiene is readily recognized as a non-ionic organic hydrocarbon of the formula $C_{12}H_{22}$.

The Examiner even acknowledged that the polyacrylic polymer allegedly disclosed in Guillaume is not ionically bonded to a crosslinking agent. The Examiner characterizes the polymer of Guillaume as “cross-linked polyacrylic polymer in the presence of dodecadiene cross-linking agent” (see paragraph no. 3 on page 4 of the June 13 Office Action).

- D. The Examiner failed to provide any reason why one of ordinary skill in the art would be motivated to use the ionic cross-linking agent disclosed in Combe in the composition of Guillaume.

As already stated above, Appellants submit that the combination of Guillaume and Combe is not supportable in view of the references non-analogous nature. Further, Appellants submit that the Examiner provided no reason why one of ordinary skill in the art

would be motivated to use the ionic cross-linking agent of Combe in the composition of Guillaume in view of Guillaume's explicit teaching that cross-linking is preferably carried out non-ionically.

Moreover, the ionic cross-linking agent of Combe is disclosed to be one that contributes to properties of the Combe cement on curing. For example:

The dissolved polymeric carboxylic acid (forming a second system) can react with some of the excess calcium hydroxide, yielding a cross-linked calcium polyacrylate salt. This can make a contribution to the development of improved mechanical properties in the material over a period of time.

See column 4, lines 53-58 of Combe.

Appellants submit that the above-quoted disclosure makes it clear that the cross-linking agent of Combe contributes to setting properties; namely, the hardness properties of the Combe cement which make it desirable as a tooth material substitute. Appellants submit that properties such as hardness and abrasion resistance are readily recognized by those ordinary skill in the art as contradictory to the gel properties recited in the present claims. Each of the independent claims of the present application recites a gel depilatory composition having a viscosity of 500,000 mPa·s to 20,000,000 mPa·s.

Appellants thus submit that those of ordinary skill in the art would have no motivation to use the cross-linking agent of Combe in the depilatory gel sheet of the present claims for the reason that it would lead to setting and hardening of the depilatory gel sheet and would thus not form the gel that is part of the invention.

With respect to Claim 5, Appellants point out that a poly(meth)acrylic acid and/or a salt thereof is explicitly recited as a component of the claimed depilatory gel sheet. Guillaume nowhere discloses or suggests the inclusion of a crosslinked poly(meth)acrylic

acid-based composition. As explained above in detail, those of skill in the art would not turn to any cross-linked poly(meth)acrylic acid disclosed in Combe as inclusion in Guillaume in view of the contradictory nature of the references in Guillaume's teaching away from ionically cross-linked polymers.

The rejection of the claims should be overturned because the Examiner failed to establish a *prima facie* case of obviousness.

E. Reasons why other claims are patentable over Combe in combination with Guillaume.

The Examiner rejected Claim 8 as obvious because "claim 8 defines an inherent solubility parameter represented by mathematical representation." The Examiner provides no basis for making such a rejection. The Examiner fails to set forth any reasonable technical basis from which it may be concluded that either Guillaume or Combe disclose a composition having the solubility characteristics of Claim 8. The present specification describes component (g) in detail on pages 19-21 of the specification.


For the reasons stated above, Appellants urge the Board to overturn the rejections under 35 U.S.C. § 112, second paragraph and 35 U.S.C. § 103(a).

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon

Customer Number
22850

Tel: (703) 413-300
Fax: (703) 413 -2220
(OSMMN 08/03)



Stefan U. Koschmieder
Registration No. 50,238